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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,773	10/04/2004	David S. Bonalle	70655.0700	5772
5514	7590	11/01/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			NGUYEN, NAM V	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2635	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/711,773

Applicant(s)

BONALLE ET AL.

Examiner

Nam V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 12 and 14 is/are allowed.
- 6) ☒ Claim(s) 10, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This communication is in response to applicant's Amendment filed August 17, 2005.

An amendment to the claims 1-5, 7-8, 10-14 has been entered and made of record in the application of Bonalle et al. for a "systems and methods for providing a RF transaction device for use in a private label transaction" filed October 04, 2004.

Claims 1-14 are pending.

#### ***Response to Arguments***

Applicant's amendment and argument with respect to the pending claims 1-7, filed August 17, 2005, are persuasive. Therefore the examiner has withdrawn the rejections.

Applicant's amendment and arguments with respect to claims 10-11 and 13, filed August 17, 2005 have been fully considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim <sup>10</sup>~~8~~ recites the limitation "said private label account identifier" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Referring to claim 11 is rejected as being dependent upon a rejected Claim 10 above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson, Jr. (US# 6,297,727) in view of Buell (US# 6,095,567).

Referring to Claim 10, Nelson, Jr. discloses a radio frequency transaction device (22) (i.e. a transponder) (column 2 line 44 to column 3 line 35; see Figures 1-9), comprising:

A first data storage area (i.e. a memory of a transponder 22) configured to store said private label account identifier (i.e. data representative of an individual identification code) (column 5 lines 42 to 66; see Figures 1 to 7), said private label account identifier (i.e. data representative of an individual identification code) associated with a private label data set owner (i.e. a recipient) and said first data storage area (i.e. a memory of a transponder 22) configured to store said private label account identifier in a first format (i.e. a binary word) (column 5 lines 42 to 66; see Figures 1 to 5); and

A second data storage area (i.e. a second memory section) configured to store a second account identifier (i.e. data representative of an another individual identification code), associated with a second owner (column 5 line 59 to column 6 line 25; column 7 line 35 column 8 line 20; column 8 line 55 to column 9 line 6; see Figures 1-9).

However, Nelson, Jr. did not explicitly disclose a second format different from said first format.

In the same field of endeavor of a personal data communication system, Buell teaches that a second format (24 or 26) (i.e. bar code or magnetic strip) different from said first format (22) (i.e. a microchip) (column 5 lines 1 to 45; see Figure 1) in order to store personal identifier information about users in a plurality of formats for a variety of industries.

One of ordinary skilled in the art recognizes the need to store personal identifier information about users in different formats of Buell in a plurality of ways to store data representative of individual identification codes of Nelson, Jr. because Nelson, Jr. suggests it is desired to provide a transponder identification and record assembly includes plurality of memory modules to store personal data information and a plurality of spaces to store corresponding

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identification codes (column 8 line 37 to column 9 line 6) and Buell teaches that a plurality of ways to store user's personal identifier for a plurality of owners (column 3 lines 47 to column 4 line 26) in order to provide a secure and different ways of storing personal identifier. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to store personal identifier information about users in different formats of Buell in a plurality of ways to store data representative of individual identification codes of Nelson, Jr. with the motivation for doing so would have been to provide a secure and flexible storage area for owners.

Referring to Claim 11, Nelson, Jr. in view of Buell disclose the radio frequency transaction device according to Claim 10, Buell discloses wherein said first format (26) is a magnetic stripe format (column 5 lines 13 to 29; see Figure 1).

Referring to Claim 13, Nelson, Jr. in view of Buell disclose the radio frequency transaction device for storing a private label account identifier, to the extent as claimed with respect to claim 10 above, and wherein said transaction device (22) is embedded in a pervasive instrument (10) (i.e. a transponder identification and record assembly) (column 4 line 51 to column 5 line 25; see Figures 2 and 5).

***Allowable Subject Matter***

Claims 1-9, 12 and 14 are allowed as evident by applicant's amendment and arguments.

Referring to claim 1, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that

Receiving an application for said transaction device from a consumer;

Communicating credit application information extracted from said application to a provider of credit services; and

Communicating service partner information extracted from said application to a service partner.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen  
October 31, 2005



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